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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,854	11/19/2003	Naomi Kaneko	OGOH:109A	5613
27890	7590	07/11/2005	EXAMINER	
STEPTOE & JOHNSON LLP 1330 CONNECTICUT AVENUE, N.W. WASHINGTON, DC 20036			MALDONADO, JULIO J	
			ART UNIT	PAPER NUMBER
			2823	

DATE MAILED: 07/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/715,854

Applicant(s)

KANEKO ET AL.

Examiner

Julio J. Maldonado

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2005.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-23 and 26-30 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☒ Claim(s) 13-23 and 26-28 is/are allowed.
6) ☒ Claim(s) 29 and 30 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

1. The rejection as set forth in Paper mailed on 01/26/2005 is withdrawn in view of Applicants' amendments filed on 04/20/2005.
2. The cancellation of claims 24 and 25 is acknowledged.
3. Claims 13-23 and 26-30 are pending in the Application.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al. (U.S. 6,310,674 B1).

Suzuki et al. (Fig.1) teach a method of forming a substrate with an electrode including the steps of providing a substrate (2); depositing an oxide conductive film (3) directly on said substrate (2) consisting of an amorphous material on a substrate at a temperature equal to or less than the crystallization temperature, wherein said conductive film (3) is an ITO film; crystallizing the oxide conductive film (3) by heating; and forming a transparent coating film (4) on said conductive film (3) film, wherein said coating film (4) has a thickness of between about 10Å and 1μm and wherein said coating film (4) is selected from a group including a synthetic resin (column 5, lines 2 – 30 and column 6, line 29 – column 7, line 26).

Suzuki et al. fail to teach wherein said resin is selected having a volume resistance in the range of $10^2 \Omega \cdot \text{cm}$ to $10^{12} \Omega \cdot \text{cm}$. However, the selection of the volume resistance is obvious to one of ordinary skill in the art at the time the invention was made because it is a matter of determining optimum process condition by routine experimentation with a limited number of species to obtain desired device specifications.

Suzuki et al. fail to teach wherein the thickness of the transparent coating film is in the range of $0.5 \mu\text{m}$ to $5 \mu\text{m}$. However, in the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie case of obviousness exists. MPEP 2144.05. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the above mentioned thickness range disclosed in Suzuki et al. to arrive at the claimed invention.

Furthermore, Suzuki et al. fail to teach wherein the thickness of the electrode is 20 nm or less. Notwithstanding, it would have been an obvious matter of design choice bounded by well known manufacturing constraints and ascertainable by routine experimentation and optimization to choose these particular dimensions because applicant has not disclosed that the dimensions are for a particular unobvious purpose, produce an unexpected result, or are otherwise critical, and it appears prima facie that the process would possess utility using another dimension. Indeed, it has been held that mere dimensional limitations are prima facie obvious absent a disclosure that the limitations are for a particular unobvious purpose, produce an unexpected result, or are otherwise critical. See, for example, *In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA

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1955); In re Rinehart, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976); Gardner v. TEC Systems, Inc., 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984); In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

Allowable Subject Matter

6. Claims 13-23 and 26-28 are allowed.

Conclusion


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Julio J. Maldonado whose telephone number is (571) 272-1864. The examiner can normally be reached on Monday through Friday.

8. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Olik Chaudhuri, can be reached on (571) 272-1855. The fax number for this group is 703-872-9306 for before final submissions, 703-872-9306 for after final submissions and the customer service number for group 2800 is (703) 306-3329.

Updates can be found at <http://www.uspto.gov/web/info/2800.htm>.

Julio J. Maldonado
July 10, 2005

Julio J. Maldonado
Patent Examiner
Art Unit 2823


George Fourson
Primary Examiner